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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,299	06/27/2003	Peter Dam Nielsen	684-011404-US(PAR)	9012

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FAIRFIELD, CT 06824

EXAMINER
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TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2614

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09/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/608,299

Applicant(s)

NIELSEN ET AL

Examiner

/BINH K. TIEU/

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/29/03 &amp; 01/10/05</u>                                   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-33 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-20 of copending Application No. 10/607,669. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a location dependent control of a mobile telephone terminal storing operating characteristics associated with specific location. When the mobile telephone number

roams into a newly detected location, the mobile telephone terminal is controlled by the operating characteristics stored in its memory.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Balogh (Pub. No.: US 2001/0024953).

***Regarding claim 1***, Balogh teaches a mobile electronic device comprising:  
a memory for associating a first location with a first plurality of operating characteristics (see figure 5, note paragraph [0049]);  
detection means for automatically detecting when the mobile device is at the first location (note paragraph [0031]);  
adoption means for adopting the first plurality of operating characteristics when the mobile device is at the first location (paragraph [0036]); and

a controller, for controlling the operation of the electronic device at least partially in accordance with the adopted operating characteristics (paragraph [0051]).

Regarding claim 2, note paragraph [0033].

Regarding claim 3, note paragraphs [0043] and [0045].

Regarding claims 4-6, note user interface UI in paragraphs [0033] and [0050].

Regarding claims 7-9, note paragraphs [0003] and [0036].

Regarding claim 10, note paragraphs [0024] and [0027].

Regarding claims 11-12, note paragraphs [0027], [0033] and [0050].

**Regarding claim 13**, Balogh teaches a method of customizing a mobile electronic device, comprising the steps of:

associating a first plurality of operating characteristics for the mobile device with a first location (note paragraph [0049]);

detecting the location of the mobile electronic device (paragraph [0031]);

adopting the first operating characteristics in the mobile electronic device when it is located at the first location (paragraph [0036]); and

controlling the operation of the mobile electronic device at least partially in accordance with the adopted operating characteristics (paragraph [0051]).

Regarding claim 14, note paragraph [0027].

Regarding claim 15, note paragraphs [0003] and [0036].

Regarding claim 16, note the memory of MS shown in figure 5, paragraph [0049].

**Regarding claim 17**, Balogh teaches an electronic device, having a plurality of user selectable options, comprising:

a user interface having a display and a user input device (i.e., user interface UI, paragraphs [0033] and [0050]);

a memory for defining a first theme and a second theme, wherein the first theme defines how an electronic device is controlled by the user input to select an option when the first theme is adopted by the electronic device and the second theme defines how an electronic device is controlled by the user input to select an option when the second theme is adopted by the electronic device (note paragraph [0049]);

selection means for selecting said first theme or said second theme for adoption by the electronic device (paragraph [0036]); and

a controller, for controlling the operation of the electronic device at least partially in accordance with the adopted one of the themes (paragraph [0051]).

Regarding claims 18-21, note paragraphs [0027], [0033] and [0050].

Regarding claim 22-24, note paragraphs [0003] and [0036].

Regarding claim 25 note paragraphs [0024] and [0027].

Regarding claims 26-27, note paragraphs [0027], [0033] and [0050].

**Regarding claim 28**, Balogh teaches a method of customizing the manner in which an electronic device, having a plurality of user selectable options, is controlled by a user to select an option (see paragraph [0027]), comprising the steps of:

providing a first theme defining how an electronic device is controlled by a user to select an option when the first theme is adopted by the electronic device (see paragraph [0033]);

providing a second theme that defines how an electronic device is controlled by the user

to select an option when the second theme is adopted by the electronic device (paragraph [0039]); and

selecting the first theme or the second theme for adoption by the electronic device (paragraph [0036]).

Regarding claim 29, note paragraph [0027].

Regarding claim 30, note paragraphs [0003] and [0036].

Regarding claim 31, note the memory of MS shown in figure 5, paragraph [0049].

**Regarding claim 32**, Balogh teaches a mobile electronic device, having a plurality of user selectable options, comprising:

a user interface having a display and a user input device (i.e., user interface UI, paragraphs [0033] and [0050]);

a memory for associating a first theme with a first location, wherein the first theme defines how an electronic device is controlled by the user input to select an option when the first theme is adopted by the electronic device (note paragraph [0049]);

detection means for automatically detecting when the mobile device is at the first location; selection means for selecting said first theme for adoption by the electronic device when the mobile device is at the first location (paragraph [0036]); and

a controller, for controlling the operation of the electronic device at least partially in accordance with an adopted theme (paragraph [0051]).

**Regarding claim 33**, Balogh teaches a method of customizing the manner in which an electronic device, having a plurality of user selectable options, is controlled by a user to select an option (see paragraph [0027]), comprising the steps of:

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providing a first theme defining how an electronic device is controlled by a user to select an option when the first theme is adopted by the electronic device (see paragraph [0033]);

detecting when the mobile electronic device is at a first location (paragraph [0031]); and adopting the first theme when the mobile electronic device is located at the first location (paragraph [0039]).

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chawla et al. (Pub. No.: US 2002/0142788) teaches a method for determining and automatically adjusting organization parameters in a wireless communication system.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (571) 272-7510 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (571) 272-7499 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL CUSTOMER SERVICE FOR THE SUBSTITUTIONS OR COPIES.**

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**/BINH K. TIEU/**  
Primary Examiner  
Technology Division 2614

Date: September 2007